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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,853	10/12/2001	Keima Takabayashi	0445-0310P	7444

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EXAMINER

TORRES VELAZQUEZ, NORCA LIZ

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/974,853		TAKABAYASHI ET AL.	
	Examiner		Art Unit	
	Norca L. Torres-Velazquez		1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 14 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 18, 2004 has been entered.

2. With regards to the use of "capable of" language in claims 6, 8, 11 and 14, it is noted that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Response to Arguments

3. Applicant's amendment and arguments to reconsider the application filed May 18, 2004 have been fully considered but they are not persuasive.

a. With regards to issues under 35 U.S.C. 112, Second Paragraph, Applicants request a clearer basis (i.e., relevant U.S. case law) as to why the present claim language does not meet the provisions of 35 U.S.C. 112, second paragraph.

The Examiner had rejected claims 1-13 (now claims 1 and 3-11 pending), because the claims are setting forth physical characteristics desired in the article, and not setting forth specific compositions which would meet such characteristics and cited Ex parte SLOB (PO BdApp) 157 USPQ 172 for support. It is noted, for example, that claim 1 recites a cleaning sheet having a cleaning surface comprising a cleaning area and a low-friction area and these areas are defined by the physical characteristic of coefficient of

static friction against wool press felt and the claim is not setting forth the specific compositions which would meet such characteristics. It is that Examiner's position that while the claimed properties (coefficient of static friction) can be measured by the outlined test for a nonwoven fabric or film, the claims do not define the specific materials/chemicals providing the specific properties. The claims are rendered indefinite since it is not proper to seek patent protection on materials/chemicals that might be discovered in the future that could provide the cleaning sheet with the presently claimed properties. The Examiner's position is further supported by:

Reciting the physical and chemical characteristics of the claimed product will not suffice where it is not certain that a sufficient number of characteristics have been recited that the claim reads only on the particular compound which the applicant has invented. *Ex parte Siddiqui* 156 USPQ 426 ; *Ex parte Davission et al.* 133 USPQ 400 ; *Ex parte Fox* 128 USPQ 157

It is necessary that the product be described with sufficient particularity that it can be identified so that one can determine what will and will not infringe. *Benger labs. Ltd. v. R.K. Laros Co.*; 135 USPQ 11; *In re Bridgeford* (CCPA 1966) 149 USPQ 55; *Locklin et al. v. Switzer Bros., Inc.* 131 USPQ 294.

b. With regards to issues under 35 U.S.C. 103(a), Applicants submitted that the cited references are not analogous art and state that the references have been improperly combined and that the requisite motivation and reasonable expectation are lacking.

Applicant's remarks are noted. The international classification is one indicator that the references are analogous. Further, it is also noted that the structures taught by the cited references are similar (i.e. nonwoven materials).

Claim Objections

4. Claim 14 is objected to because of the following informalities: on line 8 of claim 14, the word "polyamide" is incorrectly spelled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1, 3-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 11 recite physical properties of a cleaning sheet formed by a cleaning area that contains an air-laid nonwoven and a low-friction area that comprises a film or a nonwoven fabric (i.e. coefficient of static friction). *Ex parte Slob*, 157 USPQ 172, states the following with regard to an article claimed by defining property values:

Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics; thus expression "a liquefiable substance having a liquefaction temperature from about 40°C. to about 300°C. and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites compounds by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended.

Thus, claims 1 and 3-11 are indefinite for reciting only the desired physical properties of the different components of the cleaning sheet, rather than setting forth structural and/or chemical characteristics of said components.

Further, it is noted that:

Reciting the physical and chemical characteristics of the claimed product will not suffice where it is not certain that a sufficient number of characteristics have been recited that the claim reads only on the particular compound which the applicant has invented. *Ex parte Siddiqui* 156 USPQ 426 ; *Ex parte Davission et al.* 133 USPQ 400 ; *Ex parte Fox* 128 USPQ 157

It is necessary that the product be described with sufficient particularity that it can be identified so that one can determine what will and will not infringe. *Benger labs. Ltd. v. R.K. Laros Co*; 135 USPQ 11; *In re Bridgeford* (CCPA 1966) 149 USPQ 55; *Locklin et al. v. Switzer Bros., Inc.* 131 USPQ 294.

5. Claims 1, 3-11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear if on line 5 of claim 1, "said cleaning sheet" is what Applicants are trying to claim or if it meant to be "said cleaning area". Is the air-laid nonwoven fabric limited to the cleaning area? Or it is also part of the low-friction area? The same applies to the last paragraph of claim 14.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-224895 in view of JP 10-060761.

The JP 09-224895 discloses a sheet for cleaning that is composed of a base material sheet made of a nonwoven fabric and an intermediate sheet, which is a tacky adhesive and a front surface of a meshed fabric. The reference teaches that the dirt is entangled with the nonwoven fabric fibers of the front surface sheet and captured by the tacky adhesiveness or the through holes of the meshed fabric. (Abstract) The nonwoven fabric will equate the scraping part of the present invention and the meshed fabric and/or intermediate sheets equate the dust-holding part of the present invention.

However, the JP 09-224895 reference does not teach that the nonwoven fabric is air-laid.

The JP 10-060761 reference discloses a cleaning sheet produced by arranging two kinds of thermally fusible short fibers having a fiber length of 5 mm and different fiber diameters into three-dimensional structures, respectively, by an air-laying method. (Abstract)

Since both references are from the same field of endeavor, cleaning sheets, the purpose disclosed by the JP 10-060761 would have been recognized in the pertinent art of JP 09-224895.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the nonwoven material of the cleaning sheet with the motivation of preventing gathered dust from dropping as disclosed in the JP 10-060761 Abstract.

8. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-224895 and JP 10-060761 as applied to claims 1, 4-8 and 10 above, and further in view of JP 2000-328415.

The JP 09-224895 and JP 10-060761 references fail to teach the fineness of the fibers being of 23 to 200 dtex [20 d – 180d].

JP 2000-328415 discloses a nonwoven fabric produced by dispersing staple fibers composed of a hot-melting conjugate fiber of a length of 3-4 mm and a fineness of 30-80 deniers. (Abstract) With regards to the limitation requiring the cleaning sheet to be attached to a cleaning tool, it is noted that the JP 09-224895 provides such limitation on Figure 2 of the drawings.

The Japanese references cited above are from the same field of endeavor, directed to nonwoven structures classified under Int. Cl. A47L 13-16.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the nonwoven material and provide it with fibers of fineness of


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30-80 deniers with the motivation of making an absorptive article as disclosed by the JP 200-328415 Abstract/Title.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Norca L. Torres-Velazquez
Examiner
Art Unit 1771

July 21, 2004